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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,180	08/27/2003	Jay S. Walker	98-076-C1	5244

22927 7590 09/29/2005

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EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/649,180

Applicant(s)

WALKER ET AL.

Examiner

William M. Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-13,15-21,23-27 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-13,15-21,23-27 and 29-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 1.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

WILLIAM M. PIERCE
PRIMARY EXAMINER

DETAILED ACTION***Claim Rejections - 35 USC § 102***

Claims 1-3 5-11 13 15 16 17 18-21 23-27, 29-33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Riendeau 6,761,633 whose, based on his provisional application, has an effective filing date of 6/2/2000.

As to claims 1, 5-7, 10, 19-21, 26, 27, 29-31 Riendeau shows a "lottery ticket" a plurality of symbols 16 "printed " in a play area, with a continuous path 14 that is associated with a prize as shown in fig. 2G. The symbols are printed in such a way that the symbols do not have a link between them as shown in fig. 2A at nodes 01 and 16. At col. 3, ln. 38 Riendeau shows associating a prize. While nothing in the claims recites any structure to give any weight to the term Scratch-off and "thicket". Applicant may believe that the implied printed paper with removable material to conceal it is distinguishable over this applied art. However, it is considered well known to make either electronic or physical embodiments of a game. As to claims 2 and 11, the numbers with the negative signs, such as 76, are considered "void" and are a "non-continuous path" in that they need to be "bypassed" or cause negative points. Riendeau electronic embodiment covers his indicia through the programming. To have used a latex covering as called for by claims 3 and 13 would have been obvious in order to make a traditional "lottery ticket". Making manual or automating a manual activity has been held as a non-patentable advance. In re Venner, 262 F.2d 91, 95 replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. As to claim 6, 15 and 16, different path are associated with different prizes. As to claims 8, 9, 17, 18, 32 and 33, Riendeau uses a computer readable medium with a storage device. Claims 23-25 are inherent in Riendeau. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

Claim Rejections - 35 USC § 103

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riendeau in view of Sultan 6,273,817.

Riendeau shows indicia but fails to show the use of bar code indicia. It would have been obvious to have replace the indicia of Riendeau with bar code indicia in order to make it machine readable as taught by Sultan.

Art Unit: 3711

Conclusion

Applicant's arguments with respect to claims pending have been considered but are moot in view of the new ground(s) of rejection.


Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.


WILLIAM M. PIERCE
PRIMARY EXAMINER